

ATTORNEY DOCKET NO.:
43-97-001 (014208.1183)

PATENT APPLICATION
08/920,433

1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Kathryn A. Howard
Serial No.:	08/920,433
Filing Date:	August 29, 1997
Group Art Unit:	2123
Examiner:	William Thompson
Title:	METHOD AND SYSTEM OF PROVIDING ACCESS PRIVILEGES TO RECORDS OF MEMBERS OF A COMMUNITY

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PETITION TO THE COMMISSIONER UNDER 37 C.F.R. 1.181

Appellants petition the Commissioner for resolution of certain issues prior to appeal. Appellants request the relief set forth below. Appellants respectfully submit herewith their Petition and a one-month Notification of Extension of Time. Appellants understand that this Petition will likely be decided by the Group Director, as the Group Director decides "[p]etitions concerning appealed patent applications before transfer of jurisdiction to the Board of Patent Appeals and Interferences" under MPEP § 1002.02(c)(8).

STATEMENT OF FACTS

Appellants received a second and final rejection of all pending claims in the present application in the final Office Action mailed May 23, 2001 (the "Final Office Action"). Appellants filed a Notice of Appeal on May 24, 2002 (the "Notice of Appeal"). Appellants filed an Appeal Brief on July 24, 2002 (the "Appeal Brief"). The Examiner mailed a Notice of Non-Compliance With 37 CFR 1.192(c) on May 29, 2003 (9 months after Appellants filed the Appeal Brief) (the "Notice of Non-Compliance"), attached hereto as Exhibit A.

RELIEF REQUEST

1. Appellants request the Group Director to vacate the grounds of rejection because the Examiner has failed to satisfy the requirements of 35 U.S.C. § 132 and 37 C.F.R. § 1.104 regarding the rejections of Claims 1-7 and 9-21 as discussed below in Section 1 of the Arguments of this Petition.

2. In the alternative to the relief requested above, Appellants request the Group Director to declare that Appellants' case is ripe for Appeal and that Appellants' Appeal Brief is compliant under 37 C.F.R. 1.192(c), as discussed below in Section 2 of the Arguments of this Petition.

ARGUMENTS

1. The Examiner has failed to satisfy the requirements of 35 U.S.C. § 132 and 37 C.F.R. § 1.104 regarding the rejections of Claims 1-7 and 9-21. In the Notice of Non-Compliance, the Examiner suggested that this issue was a matter to petition and not a matter to appeal. *See* Notice of Non-Compliance, ninth paragraph. Appellants believe, as further discussed below, that this is an appealable matter. However, Appellants discuss below in this Petition the failure of the Examiner to satisfy the requirements of 35 U.S.C. § 132 and 37 C.F.R. § 1.104 regarding the rejections of Claims 1-7 and 9-21

A. Overview

The Examiner expressly refuses to explain how each reference teaches or suggests each and every element of the rejected claims. Instead, the Examiner cites large portions of each reference, without explaining how or why those portions are relevant to the claims. Appellants also previously argued that the references fail to teach or suggest specific elements of the claims. In response, the Examiner rejected Appellants' arguments, again without citing any specific portions of the references.

The Examiner has not provided sufficient information to allow Appellants to determine the validity of the Examiner's rejections. In particular, Appellants are forced to speculate about how the cited references are relevant to each element of the claims. As a result, the Examiner has failed to comply with 35 U.S.C. § 132 and 37 C.F.R. § 1.104(c)(2).

B. Standard

When rejecting a claim, an Examiner must:

notify the applicant thereof, stating the reasons for such rejection . . . together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application.

See 35 U.S.C. § 132(a).

Not only that, the Examiner must also:

cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.

See 37 C.F.R. § 1.104(c)(2) (*emphasis added*).

In addition, the courts have refused to "substitute speculation as to [a] rejection for the greater certainty which should come from the Patent Office." *See Application of Herrick*,

344 F.2d 713, 716 (CCPA 1965). In *Herrick*, the Examiner issued multiple rejections without any explanation of the relevance of the cited references. *See id.* at 715-16. The court stated that, to the extent the cited references were not cumulative, the "rejection can be made specific as to particular references." *See id.* at 716.

Similarly, the Board of Patent Appeals and Interferences has held that an Examiner procedurally fails to properly state a rejection by "setting forth such a broad-brush statement and by failing to explain with a reasonable degree of specificity any one rejection." *See Ex parte Blanc*, 13 U.S.P.Q.2d 1383, 1384 (Bd. Pat. App. & Intf. 1989). In that case, the Examiner issued 40 separate rejections for each claim, without any explanation of how or why the cited references were relevant. *See id.*

C. *Examiner Used Wrong Standard*

The Examiner appears to argue for two different standards in the latest Office Action. Regarding the first standard, the Examiner states that the claims are "clearly anticipated" by the cited references. *See* Office Action mailed 2/27/02, page 13, second paragraph. According to the Examiner, because Appellants are assumed to be one of ordinary skill in the art and the claims are "clearly anticipated," the Examiner has no duty to provide any additional explanation of the rejections. *See id.*

Appellants note that 37 C.F.R. § 1.104(c)(2) makes no distinction between references that "clearly anticipate" a claim and references that merely "anticipate" a claim. The Examiner cannot be relieved of the duty to cite references with specificity simply by saying that a reference "clearly anticipates" a claim. Appellants are unaware of any basis, either in statutory or case law or in the Manual of Patent Examining Procedure, that supports the first standard used by the Examiner.

Regarding the second standard, the Examiner acknowledges that when "a reference is *complex* or shows or describes inventions other than that claimed by the applicant, the

particular part relied on must be designated as nearly as practicable." *See* Office Action mailed 2/27/03, page 12, first paragraph. However, the Examiner then states that the "Examiner does not believe this application raises to the level of 'complex' especially knowing the Assignee's relative level of experience in the field of computer access models." *See id.*

The Examiner improperly focuses on the complexity of Appellants' application and the Assignee's relative level of experience. Appellants note that 37 C.F.R. § 1.104(c)(2) refers to the complexity of the cited "reference," not the complexity of the application being examined. The Examiner's statement that Appellants' "application" is not complex fails to relieve the Examiner of the duty to cite references with specificity. Also, Appellants note that 37 C.F.R. § 1.104(c)(2) makes no mention of the "Assignee's relative level of experience" in a particular field. The Examiner's reliance on the Assignee's asserted "level of experience" also fails to relieve the Examiner of the duty to cite references with specificity. Appellants are unaware of any basis that supports the second standard used by the Examiner.

D. Specificity is Required Under Proper Standard

In general, the cited references describe various techniques for granting access privileges in computer systems. These references do not fall within the realm of "non-complex" references. For example, *Rabitti* contains complex representations of access authorization concepts. Also, these references describe inventions other than Appellants' claimed invention. For example, *Abraham* describes granting different access privileges to users based on the current status (design stage, production stage, etc.) of an industrial process. As a result, under 37 C.F.R. § 1.104(c)(2), the Examiner is required to designate each part of each reference relied upon "as nearly as practicable."

E. Workshop Rejection Improper on its Face

The Examiner rejected Claims 1-7 and 9-21 under 35 U.S.C. § 102(b), as being anticipated by *Workshop*. However, the Examiner never stated which portions of *Workshop* are relied upon in making the rejection. This is the equivalent of the Examiner saying "The claims are rejected over *Workshop*." The Examiner makes no cogent attempt to read *Workshop* onto the claims, nor can Appellants determine the basis for the rejection. The Examiner failed to follow 35 U.S.C. § 132(a) and 37 C.F.R. § 1.104(c)(2) in making this rejection. As a result, the rejection of Claims 1-7 and 9-21 over *Workshop* is improper.

F. Other Rejections Lack Specificity

The Examiner also rejected Claims 1-7 and 9-21 under 35 U.S.C. §§ 102(b),(e) as being anticipated by seven other references. In making these rejections, the Examiner cites large portions of each reference, without drawing any correlation between particular teachings in the references and particular elements of Appellants' claims. For example, the Examiner cites the title, abstract, introduction, all three figures, and most of the remaining portions of *Demurjian*. See Office Action mailed 2/27/02, page 18, last paragraph. The only portions of *Demurjian* not cited by the Examiner are an eight-line review of background concepts (Section 2) and a half-column description of a figure that the Examiner did cite in the rejection (Section 2.2). The Examiner makes no attempt to describe how the cited portions relate to each element of the claims.

The Examiner has not complied with the requirements of 37 C.F.R. § 1.104(c)(2) because the Examiner failed to specify the portions of each reference relied upon "as nearly as practicable." Taking Claim 1 as an example, Appellants cannot determine which portion of *Demurjian* is relied upon as teaching "storing an assignment of a member of a community to a first position in the community to generate a first relationship." Appellants also cannot determine which portion of *Demurjian* is relied upon as teaching "automatically providing a manager of the first position with access privileges to records of the member based on the first relationship." Appellants face similar difficulties in dealing with the remaining elements of Claim 1.

The Examiner asserts that the claims are "clearly anticipated" by these references. It should therefore have been a relatively easy task for the Examiner to specify which portions of the references teach each specific element of the claims. Because the Examiner merely cites large portions of each reference without specifying how each element is taught, the Examiner has failed to identify the particular portions of the references relied upon "as nearly as practicable." Appellants have repeatedly asked the Examiner to perform this analysis since February 2001, but the Examiner has consistently refused to do so by relying on improper standards as justification.

Not only that, the Examiner actually places the burden of deducing how the references are relevant on the Appellant. For example, the Examiner stated that "[o]n the face and with a minimal amount of diligence, Appellants' representative should have been able to ascertain the relevance of each and every reference." *See* Office Action mailed 2/27/02, page 13, third paragraph. This places the burden on the Appellants to determine how the references are relevant, rather than placing the burden on the Examiner to prove that the references teach each and every element of the claims.

Beyond that, Appellants have previously pointed out that the cited references fail to teach or suggest particular elements of the claims. For example, in response to the Office Action mailed November 27, 2000, Appellants pointed out that *Howell* and *Abraham* fail to teach or suggest storing "an assignment of a member ... to a first position" and storing "an additional assignment of the member to a second position" as recited in Claims 1, 16, and 17. *See* Response filed 2/27/01, page 14, third paragraph. The Examiner's response in the next Office Action included a statement that "the prior art expressly teaches" this feature. *See* Final Office Action, page 9, first paragraph. However, the Examiner cites no support for this assertion in either the "prior art" or in the specific cited references.

In effect, the Examiner stated that the cited references anticipate the claims, but that the Examiner has no duty to show how they anticipate the claims or even to respond to

Appellants' arguments with specificity. The Examiner makes no cogent attempt to read any of the references onto the claims. Appellants cannot determine the basis for the rejections and instead must speculate about how the cited references teach or suggest each and every element of all twenty pending claims. This also improperly places the burden on Appellants to basically prove that the cited references do not teach each element of the claims, rather than properly placing the burden on the Examiner to prove that the references do teach all of the claim elements. As a result, the Examiner has failed to provide "such information and references as may be useful in judging of the propriety of continuing the prosecution of his application" as required by 35 U.S.C. § 132(a). The Examiner has also failed to designate "the particular part relied on . . . as nearly as practicable" as required by 37 C.F.R. § 1.104(c)(2). Because of this, the rejection of Claims 1-7 and 9-21 over the seven other cited references is improper.

As stated above, Appellants request the Group Director to vacate the grounds of rejection because the Examiner has failed to satisfy the requirements of 35 U.S.C. § 132 and 37 C.F.R. § 1.104 regarding the rejections of Claims 1-7 and 9-21.

2. In the alternative to the relief requested above, Appellants request the Group Director to declare that Appellants' case is ripe for Appeal and that Appellants' Appeal Brief is compliant under 37 C.F.R. 1.192(c).

A. *Appellants' Case is Ripe for Appeal.*

In the Notice of Non-Compliance, the Examiner states:

Petitionable matters are to be resolved prior to Appeal. Specifically, Appellant's statement of issue [sic] for Appeal include the petitionable issues, denoted as Issue I, and found on pages 3, and 4-9. The style in which the Examiner cites prior art is at best petitionable [sic]. If this constitutes a complaint regarding the Examiner, it must be provided in a separate paper, see 35 U.S.C. 1.3 [sic]. Matters that go [to] the merits of the formal rejections under 35 U.S.C. 102, denoted as Issues II, are ripe for Appeal. After Appellant [sic] resolves the petitionable matters, the case will be passed to the Board.

See Notice of Non-Compliance, ninth paragraph. Appellants respectfully disagree with the Examiner's assertions that issues of the Appeal Brief are not ripe for appeal.

35 U.S.C. § 134(a) states that "[a]n applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the administrative patent judge to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal." Moreover, 37 C.F.R. 1.191(a) states that "[e]very applicant for a patent or for reissue of a patent, . . . any of whose claims has been twice or finally (§ 1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee . . . within the time period . . . for reply." Appellants respectfully submit that the pending claims of the Appellants' application have been twice and finally rejected. See Office Actions mailed November 27, 2000 and May 23, 2001. Appellants have also paid the required fee and filed a timely notice of appeal. See Notice of Appeal. Thus, Appellants' case is ripe for appeal. The fact that Appellants address the failure of the Examiner to satisfy the requirements of 35 U.S.C. § 132 and 37 C.F.R. § 1.104 does not affect the ripeness of Appellants' appeal, as Appellants have been twice and finally rejected and final rejections under 35 U.S.C. § 102 are appealable.

B. Appellants' Appeal Brief is Compliant under 37 C.F.R. 1.192(c).

The Examiner issued a Notice of Non-Compliance With 37 C.F.R. 1.192(c). However, Appellants' Appeal Brief is compliant with 37 C.F.R. 1.192(c), because the Appeal Brief includes each and every item required to be included under that section, including: (1) a real party in interest statement, (2) a related appeals and interferences statement, (3) a status of claims statement, (4) a status of amendments statement, (5) a summary of invention explanation, (6) an issues statement, (7) a grouping of claims section, (8) an arguments section and (9) an appendix containing a copy of claims involved in the appeal. See Appeal Brief. Therefore, Appellants' Appeal Brief is compliant under 37 C.F.R. 1.192(c).

Appellants note that the Examiner states that Issue 1 of the Appeal Brief is petitionable. However, the Examiner cites no legal authority, either a statute, provision or otherwise, for such assertion. Moreover, Appellants have cited a previous decision of the Board of Patent Appeals and Interferences which addressed and decided the same issue as Issue 1 of the Appeal Brief. *See Ex parte Blanc*, 13 U.S.P.Q.2d 1383, 1384 (Bd. Pat. App. & Intf. 1989).

The Examiner also cites "35 U.S.C. 1.3" as requiring that a separate paper be provided for a complaint regarding the Examiner. Appellants believe the Examiner intended to cite 37 C.F.R. § 1.3. That section is directed towards conducting business with the Patent and Trademark Office with decorum and courtesy and states that papers presented in violation of this requirement will be submitted to the Commissioner. *See* 37 C.F.R. § 1.3. It also states that complaints against examiners and other employees must be made in correspondence separate from other papers. *See id.* Appellants submit that Issue 1 of the Appeal Brief is directed towards the failure of the Examiner to comply with certain requirements when rejecting claims and does not constitute a complaint against the Examiner under 37 C.F.R. § 1.3.

As stated above, in the alternative to the relief requested in Section 1 of this Arguments section, Appellants request the Group Director to declare that Appellants' case is ripe for Appeal and that Appellants' Appeal Brief is compliant under 37 C.F.R. 1.192(c).

ATTORNEY DOCKET NO.:
43-97-001 (014208.1183)

PATENT APPLICATION
08/920,433

11

CONCLUSION

For the reasons discussed above, Appellants respectfully request the Group Director to vacate the grounds of rejection because the Examiner has failed to satisfy the requirements of 35 U.S.C. § 132 and 37 C.F.R. § 1.104 or, in the alternative, declare that Appellants' case is ripe for Appeal and that Appellants' Appeal Brief is compliant under 37 C.F.R. 1.192(c).

The Commissioner is authorized to charge the statutory fee of \$130.00 to Deposit Account No. 05-0765 of Electronic Data Systems Corporation. Although no other fee is believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Appellants



Chad C. Walters
Reg. No. 48,022

Date: July 29, 2003

Correspondence Address:
2001 Ross Avenue, Suite 600
Dallas, TX 75201-2980
Tel. 214.953.6511

X Customer Number or Bar Code Label

35005